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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,533	09/19/2006	Shinichi Ogasawara	SCEP 22.456(100809-00319)	5458
26304 7590 08/11/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER DEODHAR, OMKAR A				
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3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,533

Applicant(s)

OGASAWARA ET AL.

Examiner

OMKAR A. DEODHAR

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/24/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Non-Final Rejection

Response to Amendment & Arguments

This is responsive to the RCE & claim amendments submitted on 6/4/2009.

Applicant's arguments regarding the direction of Jeong's lid opening, the alleged improper combination of references & lack of motivation were addressed in the Advisory Action dated 5/7/2009, where Examiner explained that: 1) Movement of Jeong's lid is interpreted as opening backwards with respect to the casing & a user's perspective; 2) Mical is relied upon for providing curved edges to better suit a user holding the device and 3) Providing curved edges on Jeong's device does not destroy its structure because it is an obvious modification that makes the device easier to hold. In sum, the modification yields predictable results.

Applicant's arguments drawn to the amended claim limitations are not persuasive. First of all, Applicant's amended limitation (claim 1) is deemed indefinite because, while enabled (Specification, Page 15, ¶3, Page 16, ¶1), it does not adequately describe the structure being sought to Patent. Via reference to Figure 2, Applicant's Specification discloses that casing 10 has a circular curve cross section so that its thickness decreases from its center towards both ends. However, Figure 2 does not appear to show a decreasing cross section thickness from the casing's center towards its ends. In contrast, the casing thickness appears to increase where the user grips the device. This renders claim 1 indefinite while necessitating a Drawing objection.

Applicant is respectfully requested to provide clarification and/or correction. Examiner has interpreted the claim in a manner consistent with the drawing in Figure 2.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3 & 5-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's amended limitation (claim 1) is deemed indefinite because, while enabled (Specification, Page 15, ¶3, Page 16, ¶1), it does not adequately describe the structure being sought to Patent. Via reference to Figure 2, Applicant's Specification discloses that casing 10 has a circular curve cross section so that its thickness decreases from its center towards both ends. However, Figure 2 does not appear to show a decreasing cross section thickness from the casing's center towards its ends. In contrast, the casing thickness appears to increase where the user grips the device. This renders claim 1 indefinite while necessitating a Drawing objection. Applicant is respectfully requested to provide clarification and/or correction. Examiner has interpreted the claim in a manner consistent with the drawing in Figure 2.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of casing 10 having a circular curve cross section so that its thickness decreases from its center

towards both ends must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 & 3, 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeong (US 6,813,147) in view of Mical (US 4,969,647).

Claim 1:

Jeong teaches:

A portable electronic device, comprising:
a horizontally long casing, both ends of which are capable of being gripped by a user's both hands, respectively (Figure 1);

a display unit fit into the casing (Figure 1); and

an optical disk drive unit which has a lid opening backwards and on which a detachable optical disk is loaded (Figure 5, movement of Jeong's lid is interpreted as opening backwards with respect to the front of the casing & a user's perspective),

wherein a planar region is provided at substantially a center of the rear face of the casing, and at least a part of the planar region constitutes the lid of the optical disk drive unit (Figure 5 – part of said planar region constitutes the lid of the disk drive),

Jeong does not teach:

and wherein curved shapes are formed symmetrically on both sides of the casing respectively so that fingers of the user gripping the casing placed along the curved shapes make the tips of the fingers point away from the center of the lid of the optical disk drive unit, and *a horizontally longitudinal cross section of the casing substantially perpendicular to the rear face comprises the curved shapes having gentle curves slanted from the center of the casing to the left and right hands of the user such that a width of the cross section gradually becomes narrower at both a display unit face and a rear face.*

(Mical teaches a hand-held electronic device with curved edges. See Mical Figure 1. The limitation indicated by italicized text is deemed indefinite, as explained above with respect to the section 112 rejection. The structure is interpreted in a manner consistent with Applicant's Figure 2. Mical's Figure 1 teaches this structure.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide curved edges as taught by Mical's Figure 1 on Jeong's portable electronic device for the purpose of making it easier for a user to hold. See Mical Col. 1 Lines 53-60 for this motivation. This modification yields highly predictable results because it is desirable to provide devices that are easy to hold. Known changes to the prior art utilizing known methods yielding predictable results are considered obvious.)

Claim 3:

The portable electronic device of claims 1, wherein an outer edge of each side of the casing comprises each of the curved shapes is formed as an arc shape fitting to the curve formed by a palm of the user gripping the casing.

(Jeong in view of Mical teaches the claimed arc shape. See Mical Figure 1.)

Claim 5:

Jeong teaches:

The portable electronic device of claim 1, further comprising a first operation means (Figure 1, Item 192) and a second operation means (Figure 1, Item 190 provided on the front face of the casing, wherein each of the first operation means and the second operation means is operated by a thumb of the user gripping the casing (A person may use his thumb, or any other finger to press the buttons), the first operation means is a direction instruction key (Figure 1, Item 192 teaches instruction keys) having a plurality of pressed faces each corresponding to an operation direction (Figure 1, Item 192, instruction keys corresponding to an operation direction), the second operation means is a plurality of button keys each outputting single instruction (Figure 1, Items 190 show a plurality of keys for various instructions), and the center of the direction instruction key and the center of the button keys are shifted upward in the vertical direction from the horizontal center line of the casing when viewed from the user (the keys described above are interpreted as teaching the claimed limitations).

Claim 6:

Jeong teaches:

The portable electronic device of claim 5, wherein when the casing is placed on a horizontal plane so that a face without the display unit is oriented downward (the bottom of the device is oriented downward), a top of the direction instruction key and a top of any one of the plurality of button keys are higher than the maximum height of the casing (since the keys are elevated with respect to the planar surface they reside on, they are interpreted as being higher than the maximum height of the casing when the optical drive is in its closed position. In this respect, the casing is interpreted as the planar region containing the disk drive & buttons; apart from the display.)

Claim 7:

Jeong teaches:

The portable electronic device of claim 5, wherein the front face of the casing comprises at least two areas, the direction instruction key and the plurality of button keys are placed in a first area (Figure 1, Items 190 & 192 are in a first area),

and at least one sub operation button not used during game play going on the display unit is placed in a second area, wherein the height of the first area and the height of the second area are different from each other when measured from a horizontal plane on condition that the casing is placed on the horizontal plane so that a face without the display unit is oriented downward.

(Jeong teaches buttons in a second area. See Figure 1 showing a plurality of sub operation buttons in an area different from buttons 190 & 192 & of a different height. If an interactive disk is used with the system, a game is taught.)

Claim 8:

Jeong teaches:

The portable electronic device of claim 7, wherein the second area is elevated from the first area. (See Figure 1, Button 194 is in a first area while Buttons 190/192 are in a second area elevated from the first area.)

Claim 9:

Jeong teaches:

The portable electronic device of claim 5, wherein spacing between the pressed surfaces of the direction instruction key and spacing between each button of the button keys are different from each other. (See Figure 1, spacing between directional buttons 192 & buttons 190 is different).

Claim 10:

Jeong teaches:

The portable electronic device of claim 5, further comprising an analog operation means for outputting an analog signal for direction (Figure 1, directional buttons 192),
Jeong does not explicitly teach:

wherein the analog operation means is located closer to the user than the direction instruction key and the center of the analog operation means is located inside of the center of the direction instruction key.

(It would have been a matter of obvious design choice to one of ordinary skill in the art at the time of Applicant's invention to place buttons in the claimed manner.)

Claims 11, 12:

Jeong teaches:

The portable electronic device of claim 1, wherein the surface of the casing is a resin molded part (the device is made of some type of resin),

Jeong does not teach:

the resin molded part comprising a transparent window through which the display unit can be viewed and a frame other than the transparent window, the transparent window being made of a first transparent resin, the frame being made from a second colored resin, wherein the first resin and the second resin are molded in a unified fashion by two-color molding.

(Jeong Figure 1 Item 126 teaches a transparent window through which a display can be viewed. The type of resin or plastic used for the frame & color scheme would have been a matter of obvious design choice to one of ordinary skill in the art at the time of Applicant's invention. Aesthetic considerations are viewed as matters of obvious design choice that are well within the level of ordinary skill in the art - this also applies to the limitations of claim 12).

Claims 13, 14:

Jeong teaches:

The portable electronic device further comprising a speaker within the casing, wherein a through hole is formed at the bottom face of the casing for emitting sounds generated from the speaker, the through hole being formed with an angle toward the front face of the casing.

a second through hole formed in the front face of the casing, and a duct formed inside the casing for directing sounds generated from the speaker to the second through hole.

(Jeong teaches that it is well-known in the art to place speakers at the base of the unit or on the display unit. See Col. 1. Lines 49-50. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to place speakers at the base of the unit as taught by Jeong & provide through holes & sound ducts in the claimed manner. This yields the predictable results of outputting sounds with sufficient volume & clarity.)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/

/Corbett Coburn/
Primary Examiner
AU 3714